

REMARKS

Claims 53-69 and 76-92 are pending; claims 70-75 and 93-98 have been canceled by the present amendment.

Examiner Interview

On 19 August 2009, applicant's undersigned representative conducted a telephone interview with Examiner Chi Nguyen. The following is a complete and proper recordation of the substance of the interview: (A) No exhibits were shown and no demonstrations were conducted; (B) Claims 53-69 and 76-92 were discussed; (C) Co-pending Application Nos. 10/768,677, 10/933,539, and 10/925,924 were discussed ; (D) the amendments presented above were discussed; (E) the general thrust of the principal arguments of the applicant and the examiner are those presented below; (F) no other pertinent matters were discussed; (G) the general results or outcome of the interview was that applicant would file the present amendment; and (H) the interview was not via electronic mail.

Double Patenting

Claims 53-69 and 76-92 stand rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over three applications.

-1- Over Claims 10/1-2, 4-8 and 15-26 of Co-Pending Application No. 10/768,677.

In order to expedite prosecution, Applicant hereby submits a terminal disclaimer with regard to USPN 7,637,068 (USSN 10/768,677 issued as USPN 7,637,068 on December 29, 2009). The present application and USPN

7,637,068/USSN 10/768,677 are commonly owned. Accordingly, the Examiner is respectfully requested to withdraw the double patenting rejection.

-2- Over Claims 1-38 of Co-Pending Application No. 10/933,539.

First, Applicant notes that USSN 10/933,539 is now USPN 7,171,791. Second, Applicant traverses the double patenting rejection.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. MPEP § 804(II)(B)(1). These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

As required of the Office/Examiners by MPEP § 804(II)(B)(1), any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

Further, when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

Respectfully, Applicant highlights that the pending Double Patenting Rejection (based on USSN 10/933,539) does not make clear the differences between the inventions of the conflicting claims. Had the Office attempted to make clear the differences between the inventions of the conflicting claims, the Office would have discovered that the claims of the application-at-issue recite (as set forth in exemplary claim 53):

"said locking strip is **a separate part** which is mechanically fixed to the floorboard in said horizontal direction and a vertical direction," and

"wherein the joint comprises a **strip groove** adapted to receive the strip tongue and wherein the strip groove is open in the horizontal direction."

In contrast, the claims of USSN 10/933,539 (now USPN 7,171,791) make no mention of such recitations. Moreover, the claims of USSN 10/933,539 are directly contrary to the claims of the application-at-issue. Specifically, exemplary claim 1 of USSN 10/933,539 recites that "at least parts of the lower lip¹ are ***formed integrally*** with the core of the floorboard."

Applicant highlights that a lower lip/locking strip that is "formed integrally" is formed in one piece with the core of the floorboard, such that the locking strip cannot be a separate part as prescribed in the claims of the application-at-issue. Further, with a lower lip/locking strip that is formed in one piece with the core of the floorboard, there is no reason to have a strip groove that is adapted to receive the strip tongue.

Accordingly, for at least the reasons described above, the pending claims are not obvious variants of the claims of USSN 10/933,539. Thus, granting the pending claims would not result in the unjustified extension of patent exclusivity. The rejection of claims 53-69 and 76-92 as being unpatentable over claims 1-38 of USSN 10/933,539 (USPN 7,171,791) is respectfully requested to be withdrawn.

-2- Over Claims 37 and 44-56 of Co-Pending Application No. 10/925,924.

Applicant traverses the double patenting rejection. Respectfully, Applicant highlights that the pending Double Patenting Rejection (based on USSN 10/925,924) does not make clear the differences between the inventions of the conflicting claims.

¹ The lower lip relates to the presently claimed locking strip via the following recitation in exemplary claim 1 of USSN 10/933,539: "that the lower lip has a supporting surface for coaction with a corresponding supporting surface on the tongue at a distance from the bottom end of the undercut groove, said supporting surfaces being intended to coact to counteract a relative displacement of two mechanically joined boards in a direction perpendicular to the surface plane."

Had the Office attempted to make clear the differences between the inventions of the conflicting claims, the Office would have discovered that the claims of the application-at-issue recite (as set forth in exemplary claim 53):

"said locking strip is **a separate part** which is mechanically fixed to the floorboard in said horizontal direction and a vertical direction," and

"wherein the joint comprises a **strip groove** adapted to receive the strip tongue and wherein the strip groove is open in the horizontal direction."

In contrast, the claims of USSN 10/925,924 make no mention of such recitations. Moreover, the claims of USSN 10/925,924 are directly contrary to the claims of the application-at-issue. Specifically, exemplary claim 37 of USSN 10/925,924 recites that "the locking device further includes a strip formed from the body [of the floor board]."

Applicant highlights that a locking strip that is formed is "formed from the body" is formed in one piece with the body of the floorboard, such that the locking strip cannot be a separate part as prescribed in the claims of the application-at-issue. Further, with a locking strip that is formed in one piece with the body of the floorboard, there is no reason to have a strip groove that is adapted to receive the strip tongue.

Accordingly, for at least the reasons described above, the pending claims are not obvious variants of the claims of USSN 10/925,924. Thus, granting the pending claims would not result in the unjustified extension of patent exclusivity. The rejection of claims 53-69 and 76-92 as being unpatentable over claims 37 and 44-56 of USSN 10/925,924 is respectfully requested to be withdrawn.

Conclusion

The Examiner is respectfully requested to enter the foregoing amendments prior to examination of the application. In the event that there are any questions, the Examiner is respectfully encouraged to contact the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date 2 February 2010

By: _____

A handwritten signature in black ink, appearing to read "T.D. Boone". The signature is written in a cursive, stylized font.

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